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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,803	07/14/2003	Linda Najdek	98.22US-CON	5789
7590 Estee Lauder Companies 125 Pinelawn Road Melville, NY 11747			EXAMINER FISHER, ABIGAIL L	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 11/21/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/618,803	NAJDEK ET AL.	
	Examiner	Art Unit	
	ABIGAIL FISHER	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-5 and 7-22 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examiner for your application in the USPTO has changed. Examiner Abigail Fisher can be reached at 571-270-3502.

Receipt of the Appeal Brief filed on October 3 2008 is acknowledged. Claim 6 was/stand cancelled. Claims 1-5 and 7-24 are pending.

Applicant's arguments, see page 6-14 of the appeal brief, filed October 3 2008, with respect to the rejection(s) of claim(s) 1,2,4-5, 7-9 and 11-19 over Touzan et al. in view of Shah et al. and claims 1,2, 4-5, 7-8, 10-20 and 22 over Nagy et al. in view of Grollier et al. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art references. The new grounds of rejection are set forth below.

Claim Objections

Claims 23 and 24 are indicated as withdrawn. However, there is no text corresponding to these claims. Only claims with the status of "canceled" or "not entered" may be presented with no text. **Note MPEP 714** item 4. Appropriate correction is required.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 4-5, 7-9 and 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (WO 92/09266, cited on PTO Form 1449) in view of

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Nagy et al. (US Patent No. 5871758, cited in the Office action mailed on 12/28/07) as evidenced by Sakellariou et al. (Colloid Polym. Sci. 1995).

Applicant Claims

Applicant claims a dual phase liquid cosmetic or pharmaceutical composition comprising an aqueous phase and an oil phase, each phase being separate from the other except when mixed at the time of use, comprising the step of adding to one of the phases of the composition as a demixing agent an effective amount of a non-cationic film forming agent.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Davis et al. is directed to two-component pharmaceutical compositions for topical application. The composition comprises two distinct phases wherein at least one contains a drug dissolved therein. The phases each have a different liophilicity (page 2, lines 1-6). It is taught that duration of the supersaturated state is limited by evaporation taking place after the phases mix together (page 2-3, lines 34-36 and 1-2). The two phases are intended to be mixed together on or immediately prior to application (page 4, liens 1-5). It is taught that the two phases are physically and/or chemically different (page 4, lines 7-9). The proportion of first liquid phase to the second is from 1:1 to 1:12 (page 5-6, lines 34-35 and 1-2). It is taught that water is a necessary component of the second liquid phase (page 6, lines 17-19). The first liquid phase comprises more than one liquid that is generally more lipophilic or less-polar (column 6, lines 20-22). The compositions include anti-nucleating agents such as polyvinylpyrrolidone (example 1, 5, and 6) in an amount up to 10% by weight (page 8, lines 14-27). It is taught that the

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choice of anti-nucleating agent can readily be selected by simple experiment. For example preparing samples of the desired final supersaturated drug solution (i.e. mixed solution) and then adding the anti-nucleating agent allowing the samples to stand for say 2 hours and noting which solutions remain clear (i.e. phases separate) (page 9, lines 1-8). It is taught that the compositions of the invention are suitable for any medical, cosmetic or other treatment of the body surface (column 10, lines 14-20). The composition may comprise a variety of drugs (page 11, lines 8-17).

**Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)**

Davis et al. do not teach that the first liquid phase comprises an oil, although Davis et al. do teach it is generally more lipophilic or less-polar than water. However, these deficiencies are cured by Nagy et al.

Nagy et al. is directed to dual phase cosmetics. It is taught that the compositions can be utilized as a liquid dual phase makeup removal composition (claim 15) or for therapeutic purposes (column 3, lines 66-67). It is taught that these compositions provide a broad range of cleansing/conditioning potential within a single product (column 1, lines 10-12). It is taught that oil soluble actives may be unstable if in prolonged contact with the aqueous phase (column 1, lines 42-44). It is taught that the oil phase may be any cosmetically or pharmaceutically acceptable oil (column 3, lines 18-21). It is taught that in a preferred embodiment the oil phase comprises a combination of both volatile and non-volatile oil. The amount of volatile oil used is higher than non-volatile oils. One specific combination is volatile silicone and volatile paraffin. A specific combination is cyclic silicone at 25-40% by weight, C₁₆ isoparaffin in 15-30% by weight

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and the non-volatile silicone at 0.1 to 1% by weight. A preferred non-volatile silicone is dimethicone. One other exemplified oils include isohexadecane. Other hydrocarbons listed as suitable include decane, dodecane, tridecane, tetradecane, etc. (column 3, lines 29-30).

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art to combine the teachings of Davis et al. and Nagy et al. and utilize oils in the first liquid phase. One of ordinary skill in the art would have been motivated to utilize oils as Davis et al. teach two phase compositions that can be utilized for any medical, cosmetic or other treatment of the body surface and the first phase is one that is generally more lipophilic or less-polar. Nagy et al. teach dual phase compositions that are utilized for cosmetic or pharmaceutical purposes that provide a broad range of cleansing/condition potential within a single product. Therefore, one of ordinary skill in the art would have been motivated to utilize the oils taught by Nagy et al. in the composition of Davis et al. One of ordinary skill in the art would have been motivated as both are directed to similar products with similar uses and Nagy teach that these dual phase compositions provide a broad range of cleansing/conditioning potential. Furthermore, one of ordinary skill in the art would have been motivated to utilize a oil depending on the active utilized. If a more oil soluble active was utilized in the composition then one of ordinary skill in the art would have been motivated to utilize an oil as taught by Nagy et al.

Regarding applicants claim that the polyvinylpyrrolidone is a demixing agent; Davis et al. do not utilize this particular verbage. However, it is taught that the choice of

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anti-nucleating agent, of which PVP is one choice, can readily be selected by simple experiment. For example preparing samples of the desired final supersaturated drug solution (i.e. mixed solution) and then adding the anti-nucleating agent allowing the samples to stand for say 2 hours and noting which solutions remain clear (i.e. phases separate). Furthermore, as evidenced by Sakellariou, PVP is known in the art to cause phase separation (abstract, page 287, left column, second paragraph).

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. in view of Nagy et al. as evidenced by Sakellariou et al. in further view of Smith (US Patent No. 5658559, cited on PTO Form 1449).

Applicant Claims

Applicant claims that the film forming agent is polyvinylpyrrolidone hexadecane copolymer.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

The teachings of Davis et al., Nagy et al, and Sakellariou et al. are set forth above. Specifically, Davis et al. teach two-component preparations. It is taught that duration of the supersaturated state is limited by evaporation taking place after the

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phases mix together. Nagy et al. teach dual phase compositions comprising oil.

Sakellariou et al. teach that PVP is known in the art to cause phase separation.

**Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)**

Davis et al. do not specify that the polyvinylpyrrolidone polymer is polyvinylpyrrolidone hexadecene. However, this deficiency is cured by Smith.

Smith is directed to lotions for the treatment of a skin disease or disorder. It is taught that these composition comprises a barrier polymer to prevent evaporation loss of moisture from the skin (column 4, lines 8-11). Useful polymers include polyvinylpyrrolidone, copolymers of vinylpyrrolidone and eicosene, copolymers of vinylpyrrolidone and hexadecane, etc. (column 4, lines 15-32).

***Finding of Prima Facie Obviousness Rational and Motivation*
(MPEP §2142-2143)**

It would have been obvious to one of ordinary skill in the art to combine the teachings of Davis et al., Nagy et al. and Smith and utilize copolymers of vinylpyrrolidone and hexadecane (PVP/hexadecane). One of ordinary skill in the art would have been motivated to utilize this polymer as Smith teaches that it prevents evaporation loss of moisture from the skin and Davis et al. teach that evaporation determines the duration of the supersaturated state. Furthermore, one of ordinary skill in the art would have been motivated to replace polyvinylpyrrolidone with copolymers of vinylpyrrolidone and hexadecane (PVP/hexadecane) as both are taught by Smith as functional equivalents.

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Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6649174. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims overlap in scope.

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The instant application claims a dual phase liquid cosmetic or pharmaceutical composition comprising an aqueous phase and an oil phase, each phase being separate from the other except when mixed at the time of use, comprising the step of adding to one of the phases of the composition as a demixing agent an effective amount of a non-cationic film forming agent.

Patent '174 claims a liquid dual phase makeup removal composition comprising an oil phase and an aqueous phase each phase being separate from the other before and after mixed at the time of use, the composition containing as a demixing agent an effective amount of a non-cationic copolymers of vinylpyrrolidone. Patent '174 claims all the instant limitations in the dependent claims.

Therefore, the scopes of the patent claims and the instant application overlap and thus they are obvious variants of one another.

Response to Arguments

The examine acknowledged applicants submission of a terminal disclaimer on August 1 2008. However, the terminal disclaimer was not approved for the following reasons:

The application/patent being disclaimed has not been identified.

Therefore, the non-statutory double patenting rejection is maintained.

Conclusion

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher
Examiner
Art Unit 1616

AF

/Johann R. Richter/
Supervisory Patent Examiner, Art Unit 1616